

**REMARKS****Status of claims and support of claim changes**

Claims 1-17 are patented claims of the original patent and remain pending in this application. Claims 18-98 were previously added in this application and are being cancelled with the present amendment. Claims 99-166 are being added with the present amendment. Support for claims 99-166 may be found in the specification at least in the text from column 1, line 67 to column 19, line 49.

**Claim Construction**

The following discussion about claim construction is pertinent only to the newly added claim. The claims of the original patent remain "as is" and are not to be affected by the following discussion regarding claim construction. Claims 99 – 166 are being added by the present amendment. Each dependent claim refers to either an independent claim or another dependent claim. Applicant hereby states its express intent that each dependent claim be construed and attributed meaning as having at least one additional limitation or element not present in the claim to which it refers. Likewise, the claim to which each dependent claim refers is to be construed and attributed meaning as being broader than such dependent claim.

As an example, several dependent claims include the limitation "wherein the request for content is caused by a reference in a webpage". Thus, the claims to which such dependent claims refer, are to be construed as not being limited to the request for content being caused by a reference in the webpage, rather the advertisement may be inserted into the webpage using other mechanisms, such as server side scripts (e.g CGI, PHP, etc.). The advertisement may for example be in the form of a text advertisement (stored in a database), which is incorporated at the server-side into the script of a web

page served to the browser (in which cases the request for content would be responded to by serving the general web page content together with the advertisement.)

Claims 99, 133 recite: “a monetary amount an advertiser associated with the submitted bid is *willing* to pay”. This means that the “amount” is what the advertiser is *willing* to pay. It should therefore be understood that the system could optionally discount the *actual* amount the advertiser pays in the event the bid is selected and the specific event occurs. The discount on behalf of the advertiser may take into account various factors. The system may discount the actual amount to an increment above an amount of another submitted bid. The system may also discount the amount based on the quality of the web page on which the selected advertisement is displayed.

The phrase “each set of bidding parameters being associated with one or more of the plurality of advertisements” means that more than one advertisement may be associated with a set of bidding parameters. The bidding parameters may indicate that the system is to display the advertisements in a sequence each time a particular viewer who meets criteria of the bidding parameters is encountered (see col. 13, line 65 – col. 14, line 5). Alternatively, the bidding parameters may be indicative of other criteria for when to display which of the associated advertisements.

The term “specific event occurs” means that a specified event, such as a display or click-through occurs to an advertisement associated with the bid. The term “same respective event”, means that the event that triggers payment is a same respective event for all bids. For example, the same respective event may be a serving of respective advertisements associated with the bids, or the same respective event may be a click-through on respective advertisements associated with the bids. Alternatively, the same event is a 2-minute display of respective advertisements associated with the bids (However, a 1-minute display of an associated advertisement for one bid and a 2-minute

display of an associated advertisement of a second bid, are essentially not a “same respective event”).

The phrase “wherein the selection of the selected bid is based on the selected bid being determined in the computer system as having a highest beneficial value” means that the selected bid is determined by the system to result or expecting to result in the most revenue for the system operator, to the web site owner and/or other beneficiaries of the underlying advertising opportunity. The claim term should be construed to encompass embodiments wherein the system determines the beneficial value of a bid by taking into account the probability that the event that triggers payment of the monetary amount would occur. When the specific event is a serving of an advertisement to a browser, then the bid with the highest beneficial value will generally be determined by the system as corresponding to the bid associated with the highest monetary amount.

It should be understood that the pending claims 99 – 166 (except for claims 111 and 145) are to be construed such that the system does not necessarily collect and maintain information about viewers, web pages and websites. Information about viewers, web pages and/or websites may be determined in real time. Nor should the claims be limited as to the manner and form of maintaining the advertisements. Thus, each advertisement may be stored in an individual file, or alternatively multiple advertisements may be maintained in a database. It should further be understood that the claims are to be construed such that a single request for content may be indicative of one or more advertising opportunities.

### **Inventorship**

An Information Disclosure Statement was filed on November 7, 2007. Citation EA, entitled “*Roth’s Transmittal of Preliminary Statement and Notice*”, is a copy of a submission in Interference No. 104,443 relating to the original patent of which the

present application is a reissue. The document states that the invention was *jointly* conceived by the named inventors, David Roth and Dylan Salisbury, on or before June 1, 1996. Attached to the document is a copy of a specification of the invention, with a revision date of July 14, 1996. The specification was authored by one of the inventors, David Roth, the CTO of Flycast Communications Corp. ("Flycast"), the original assignee.

It has come to the attention of Applicant (the current assignee) that Dylan Salisbury joined Flycast only as of August 1996. Therefore, Applicant in communication with Mr. Salisbury evaluated whether Mr. Salisbury can be deemed a joint-inventor. After careful review, Mr. Salisbury believes he is a joint inventor *at least* as to step (d) of patented claim 16 and step (d) of patented claim 17, both reciting "Selecting the highest bid among the electronic bids *received within a specified time period*". Mr. Salisbury believes he is a joint inventor as to the limitation "*received with a specified time period*". Additionally, Mr. Salisbury believes he is a joint-inventor as to newly added claims 132 and 166.

Applicant respectfully requests the Examiner to take note of this inventorship issue and to advise Applicant if any further action by applicant is deemed necessary.

### **Related Applications**

The present application is related to: (1) Appl. No. 09/216,206, a continuation-in-part of U.S. Patent No. 6,285,987 ("987 Patent"), the original patent of which this application is a reissue; (2) Appl. No. 09/372,416, a continuation-in-part of the '987 Patent. Both of said related applications are undergoing active examination. The present application is also related to a number of continuation applications of the '987 Patent, for which the examination process has yet to begin.

**CONCLUSION**

The present application is believed to be in condition of allowance. For any outstanding issues concerning the present application the Examiner is respectfully requested to contact the undersigned at the number listed below.

Dated: December 5, 2007

Respectfully submitted,

/Benzion A. Wachsman/

Benzion A. Wachsman for assignee

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\* A statement under 37 CFR § 3.73(b) is being concurrently submitted.